

REMARKS

This responds to the Office Action dated April 8, 2005. No claims are amended, canceled or added herein. Thus, claims 1-47 remain pending in this application.

§103 Rejection of the Claims

Applicant respectfully submits that neither the asserted teachings of the references nor the motivation to combine the references are based on objective evidence, but are rather based on conclusory statements. A *prima facie* case of obviousness requires, among other things, references that teach or suggest all the claim limitations. (MPEP §§2142-43, citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)). The references need to be specifically applied to the language of the claims, and a clear rationale for the rejection must be given based on objective evidence. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Such information or references are to be given as may be useful in aiding Applicant to judge the propriety of continuing the prosecution. 37 CFR §1.104(a)(2). When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable, and the pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified. 37 CFR §1.104(c)(2). "The factual inquiry whether to combine references must be thorough and searching. It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions and cannot be dispensed with." *In re Sang-Su Lee*, 277 F.3d 1338, 1343 (Fed. Cir. 2002). "The board cannot rely on a conclusory statement when dealing with particular combinations of prior art and specific claims, but must set for the rationale on which it relies." *Lee*, at 1345.

Claims 1-8, 21 and 22 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Meyer et al. (U.S. Patent No. 6,175,635) in view of Schiess et al. (U.S. Patent No. 5,265,168). Applicant respectfully traverses for at least the following reasons. Applicant respectfully submits that the prima case of obviousness has not been provided.

Meyer purports to simultaneously set a number of correspondingly combined or derived audiological / acoustical parameters by actuation of one final control element (col. 1 lines 38-40), and uses output contacts A1-A8 connected to individual elements 2-9 and various connections between input contacts E1-E4 to the output contacts (col. 4 lines 41-46). Applicant cannot find a showing or fair suggestion of an externally-accessible device to select a parameter, and an externally-accessible device to adjust the selected parameter. The rejection states: *Schiess teaches a parameter-select device to select a parameter of the plurality of parameters to be adjusted; and a parameter-adjust device to adjust the parameter selected by the parameter select device (See Fig. 1 and col. 3, lines 26-56).* Applicant respectfully disagrees. The portion of the Schiess reference relied upon refers to a MTO switch 9, actuators/trimmers 10, and an actuation element 21 of a volume control designed as a potentiometer 12. The MTO switch 9 is used to switch the hearing aid on (microphone mode), to switch the hearing aid to a telephone mode, and to switch the hearing aid off (col. 3 line 37-41). The actuators/trimmers 10 are used to vary or set the characteristics of an amplifier unit (col. 3 lines 41-43). It is unclear to Applicant what the Examiner considers to be a parameter-select device to select a parameter of the plurality of parameters to be adjusted, and what the Examiner considers to be a parameter-adjust device to adjust the parameter selected by the parameter select device. Pursuant to 37 CFR §1.104, Applicant respectfully requests the Examiner, should the rejection be maintained, to clearly identify the elements considered to be a parameter-select device to select a parameter of the plurality of parameters to be adjusted, and a parameter-adjust device to adjust the parameter selected by the parameter select device, as recited in claim 1.

With respect to independent claim 1, Applicant cannot find, in the cited portions of the Meyer and Schiess references, objective evidence that shows or fairly suggests a hearing aid that includes, among other things, a parameter-select device accessible externally from the housing to select a parameter of the plurality of signal processing parameters to be adjusted, and a parameter-adjust device accessible externally from the housing to adjust the parameter selected

by the parameter-select device, as recited in the claim. Claims 2-8 depend on independent claim 1, and are believed to be in condition for allowance at least for the reasons provided with respect to claim 1.

With respect to independent claim 21, Applicant cannot find, in the cited portions of the Meyer and Schiess references, objective evidence that shows or fairly suggests a method of operating a hearing aid where, among other things, one of the parameters is selected with a parameter-select device on an external surface of the housing, and the selected parameter is adjusted with a parameter-adjust device on an external surface of the housing, as recited in the claim. Claim 22 depends on claim 21 and is believed to be in condition for allowance at least for the reasons provided with respect to claim 21.

Claims 9 and 10 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Meyer et al. (U.S. Patent No. 6,175,635) in view of Schiess et al. (U.S. Patent No. 5,265,168) as applied to claim 1 above, and further in view of Martin (U.S. Patent No. 6,130,950). Applicant respectfully traverses for at least the following reason. The combination of Meyer, Schiess and Martin still do not show or fairly suggest claim 1. Claims 9-10 depend on independent claim 1 and are believed to be in condition for allowance at least for the reasons provided with respect to claim 1.

Claim 31 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Meyer et al. (U.S. Patent No. 6,175,635) in view of Schiess et al. (U.S. Patent No. 5,265,168) as applied to claim 21 above, and further in view of Martin (U.S. Patent No. 6,130,950). Applicant respectfully traverses for at least the following reason. The combination of Meyer, Schiess and Martin still do not show or fairly suggest claim 21. Claim 31 depends on claim 21 and is believed to be in condition for allowance at least for the reasons provided with respect to claim 21.

Claims 32-38 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Svean et al. (U.S. Patent No. 6,657,524). Applicant respectfully traverse for at least the following reasons. Applicant respectfully submits that the prima case of obviousness has not been provided.

With respect to independent claim 32, Applicant is unable to find in Svean a showing or fair suggestion of a hearing aid comprising, among other things, a first memory device in the housing to store first parameters, a second memory device in the housing to store second parameters, a memory select device on an external surface of the housing to select the first parameters in the first memory device or the second parameters in the second memory device, and a signal processing circuit coupled between the microphone, the receiver, the first memory device, and the second memory device in the housing to process the input signal from the microphone and the output signal to be transmitted to the receiver according to the first parameters or the second parameters, as recited in the claim. Claims 33-38 depend on claim 32, and are believed to be in condition for allowance at least for the reasons provided with respect to claim 32.

The rejection refers to an EEPROM (E10) as a first memory device and a RAM (E8) as a second memory device. However, Applicant cannot find any objective evidence that shows or fairly suggests that the EEPROM stores first parameters and the RAM stores second parameters that are used by the signal processing circuit to process the input signal from the microphone and the output signal to be transmitted to the receiver. Furthermore, Applicant respectfully submits that the reference does not show a memory select device on an external surface of the housing to select the first parameters in the first memory device or the second parameters in the second memory device. The rejection admits that Svean does not expressly disclose that the manual control device selects specific parameters from the EEPROM (E10) or the RAM (E8). The rejection states: *It would have been obvious to one of ordinary skill in the art at the time of the invention that the parameters to be changed by the manual control are stored in either one or both of ROM and EEPROM for use when the device is in use to prevent the loss of the parameter operational characteristic when the device is not in use.* Applicant notes that this statement in the rejection is not applied to the claim language as it does not assert that “the first parameters in the EEPROM” or “the second parameters in the RAM” are selected by a “memory select

device.” Additionally, Applicant submits that the statement does not provide a technical line of reasoning sufficient to instantaneously and unquestionably demonstrate that the missing language of claim 32 is in fact well known.

The §103 rejection relies on a single reference, and indicates that the Svean reference does not show the entire claim. Thus, it appears that the Examiner is taking official notice of the portions of the claim not found in the Svean reference. Applicant respectfully asserts that the rejection does not provide Applicant with an explicit basis with a technical line of reasoning sufficient to instantaneously and unquestionably demonstrate that the missing language is in fact well known. Thus, Applicant respectfully traverses this official notice, and requests the Examiner to provide objective evidence by providing either a reference that describes such an element or an affidavit pursuant to 37 CFR §1.104(d)(2).

Allowable Subject Matter

Applicant acknowledges the allowance of claims 42-47.

Claims 11-20, 23-30 and 39-41 were objected to as being dependent upon a rejected base claim, but were indicated to be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicant acknowledges the indication of allowable subject matter. For the reasons provided above, Applicant believes the base independent claims for these claims are in condition for allowance, and thus believes that claims 11-20, 23-30 and 39-41 are also in condition for allowance.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 373-6960 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.


Respectfully submitted,

JOYCE ROSENTHAL

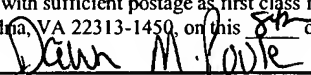
By his Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
P.O. Box 2938
Minneapolis, MN 55402
(612) 373-6912

Date 9-8-05

By 
Marvin L. Beekman
Reg. No. 38,377

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 8th day of September, 2005.


Name


Signature